

REMARKS

Claims 1-33 are pending in the present application. Claims 1, 11, 18, 19 and 23-29 have been amended, Claims 30-33 have been added, and Claim 10 has been cancelled, herewith. Reconsideration of the pending claims is respectfully requested.

Applicants would initially like to thank the Examiner for taking the time to conduct a telephonic interview for this case on 06/17/2004. While no agreement was reached, Applicants' representative emphasized the mobile device location determination with respect to electronic coupon delivery as being a distinguishing feature over the cited art.

I. Claim Objection

The Examiner objected to Claim 1 as missing a prepositional modifier. Applicants have amended Claim 1 to include a missing word of "to". Therefore, this objection has been traversed.

II. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claims 1-5, 7-8, 11-20, 24-25 and 27-28 under 35 U.S.C. § 103 as being unpatentable over Laor (US 6,041,309) in view of Hidary (US 5,852,775). This rejection is respectfully traversed.

Applicants have amended Claim 1 to clearly differentiate the claimed invention from the teachings of the cited references and to further highlight features of the determined user location with respect to coupon delivery. In particular, Claim 1 has been amended to recite "wherein the step of delivering coupons based on selected service preferences and location further comprises selecting coupons for merchants that are within a defined area of the user's location". As can be seen, Claim 1 recites that the coupon delivery is based on two items – (i) selected service preferences (from the user) and (ii) location of the user. In addition, as part of this coupon delivery, coupons are selected for merchants that are within a defined area of the user's location. These claimed features further emphasize advantages of the claimed invention, where delivered coupons can be provided for merchants within a general area of the user to, in effect, customize what coupons are delivered to a user based on the user's location and selected

service preference(s). In rejecting Claim 10 (which, prior to being cancelled, was similar to what is now recited in Claim 1), the Examiner stated that while neither Laor or Hidary teach a determined location being used for merchant selection within a prescribed user location radius, Green is considered to disclose such merchant selection at Green column 5, lines 9-20. Applicants show that there, Green states:

“Preferably, the transponders selected are those in the general vicinity of the rover 16. Determination of the general vicinity requires a preliminary position determination which may be done by, e.g., performing a coarse position determination using one or more of the aforementioned AOA, TOA or TDOA techniques without the benefit of the signals from the transponders 12, using a different relatively low-resolution location technique, or simply defining the general vicinity as a predetermined area around the base station 14. Alternatively, the base station 14 may send the wake-up call to all transponders within its communication area. Further, the base station 14 need not send the wake-up call to all targeted transponders 12 itself, and it may instead send requests to other base stations 14 close to it to issue some of the wake-up calls.”

This passage describes a selection of which transponders to send wake-up calls to, the selected transponders being used to determine the position of a rover that has sent an emergency E-911 call (Col. 5, lines 24-32). Determining of which transponders are within an area, to be used for determining location of a rover/user is different from the claimed, in that the teachings of the cited passage merely teach a technique for determining a user location. Amended Claim 1 goes further, and in addition to claiming a step of “determining the location of the user”, Claim 1 *uses this determined location information* in determining what coupons to deliver to the user by selecting coupons for merchants within a defined area of the user’s location. The cited Green passage merely determines a user’s location. Thus, it is shown that amended Claim 1 is not obvious in view of the cited references as there are missing claimed features not taught or suggested by the cited references.

Applicants traverse the rejection of dependent Claims 2-5, 7 and 8 for reasons given above regarding independent Claim 1.

With respect to Claim 11, such claim has been amended to clearly differentiate the claimed invention from the teachings of the cited references and to further highlight

features of the determined user location with respect to coupon delivery. In particular, Claim 11 has been amended to recite "wherein the received coupons pertain to merchants within a defined area of the location of the mobile communications device". As described above with respect to Claim 1, the combination of Laor/Hidary/Green merely determines a location of a user. Thus, amended Claim 11 is shown to not be obvious in view of the cited references as there are missing claimed features not taught or suggested by the cited references.

With respect to dependent Claims 12-17, Applicants traverse for reasons given above regarding independent Claim 11.

With respect to Claim 18, such claim has been amended to clearly differentiate the claimed invention from the teachings of the cited references and to further highlight features of the determined device location with respect to coupon delivery. In particular, Claim 18 has been amended to recite "receiving coupons based on selected service preferences and present physical location of the mobile communications device". As can be seen, the coupons that are received are based on both (i) the selected service preferences, and (ii) the present physical location of the mobile communications device. As described above with respect to Claim 1, the combination of Laor/Hidary/Green merely determines a location of a user. There is no teaching or suggestion of use of the information as part of the coupon selection process. Thus, amended Claim 18 is shown to not be obvious in view of the cited references as there are missing claimed features not taught or suggested by the cited references.

With respect to dependent Claims 19 and 20, Applicants traverse for reasons given above regarding independent Claim 18.

With respect to Claim 24, Applicants traverse for similar reasons to those given above regarding Claim 1.

With respect to Claim 25, Applicants traverse for similar reasons to those given above regarding Claim 11.

With respect to Claim 27, Applicants traverse for similar reasons to those given above regarding Claim 1.

With respect to Claim 28, Applicants traverse for similar reasons to those given above regarding Claim 11.

Therefore, the rejection of Claims 1-5, 7-8, 11-20, 24-25 and 27-28 under 35 U.S.C. § 103 has been overcome.

B. The Examiner rejected Claims 6, 9-10, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Laor (US 6,041,309) in view of Hidary (US 5,852,775) in further view of Green, Jr. (US 5,926,133). This rejection is respectfully traversed for similar reasons to those given above regarding their respective independent Claims 1 and 18.

Therefore, the rejection of Claims 6, 9-10, 21 and 22 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claims 23, 26 and 29 under 35 U.S.C. § 103 as being unpatentable over Laor (US 6,041,309) in view of Hidary (US 5,852,775) in further view of Christensen (US 6,035,280). This rejection is respectfully traversed.

With respect to Claim 23 (and similarly for Claims 26 and 29), such claim has been amended to correct a few antecedent basis matters. As to the rejection of Claim 23 (and similarly for Claims 26 and 29), Applicants show that none of the cited references teach or suggest the claimed step of "filtering the coupons to be sent to a consumer based on the location of the user as determined by a wireless communications system". In rejecting Claim 23, the Examiner acknowledges that neither Laor or Hidary teach this claimed filtering step, but states that "Christensen is considered to disclose the claimed feature of consumer profiles based on demographic characteristics with a filtering step at column 9, lines 4-55. Applicants show that there, Christensen states:

"A consumer may download Virtual Coupon.TM. data from a SELECTSOFT.TM. Website after uploading consumer demographic information.

SELECTSOFT.TM. diskette 310 may be provided with a date code such that the software within SELECTSOFT.TM. diskette will become disabled once the date indicated by the date code has elapsed. Once the date has elapsed, the consumer may be prompted to call the 1-800 number to receive a new diskette or receive a new authorization number or download new Virtual Coupon.TM. data.

By providing a date code, Virtual Coupons.TM. generated by the

SELLECTSOFT.TM. diskette may be provided with an effective expiration date in addition to expiration dates which may be printed on the face of the Virtual Coupon.TM.. In order to reduce material costs and environmental impact issues, SELLECTSOFT.TM. diskette 310 may be mailed with a return postage paid mailer for return of the diskette once all Virtual Coupons.TM. have been redeemed or when a new diskette has been issued.

In SELLECTSOFT.TM. BBS or Website embodiments, individual Virtual Coupons.TM. may be provided with date codes. Each Virtual Coupon.TM. may be displayed with a "redeem by" date. A consumer may download such Virtual Coupons.TM. and view them at any time locally on his or her own computer. If one or more of the downloaded Virtual Coupons.TM. have expired, a consumer may be prompted to reconnect to the SELLECTSOFT.TM. BBS or Website to download a fresh set of Virtual Coupons.TM. for redemption.

The home computer owner demographic may be a desirable demographic for retailers to reach. Typically, home computer owners have higher education and income levels and may have larger amounts of disposable income. Moreover, the home computer user demographic, although changing rapidly, is heavily male. Paper Virtual Coupons.TM. traditionally have a largest responding audience amongst females. Thus, SELLECTSOFT.TM. diskette 310 may more readily reach desirable consumer demographic groups missed by traditional paper Virtual Couponing.TM. techniques.

In step 503, a consumer may load SELLECTSOFT.TM. diskette 310 into his or her computer either by running the SELLECTSOFT.TM. software from the B:.backslash. drive, or by loading at least a portion of the SELLECTSOFT.TM. software into the hard drive of the consumer's computer. In Windows.TM. applications, an icon may be generated on the consumer's Window.TM. screen. The consumer may click on such an icon to initiate operation of the SELLECTSOFT.TM. software. In order to prevent or reduce fraud, the portion of the SELLECTSOFT.TM. software stored on a consumer's hard drive may prompt the consumer to insert the SELLECTSOFT.TM. diskette 310 into the consumer's B:.backslash. drive (or the like)."

As can be seen, there is no mention of filtering coupons to be sent to a consumer *based on the location of the consumer as determined by a wireless communication system*, as claimed. In addition, because of Christensen's desire to use user-supplied demographic information to tailor or customize coupons (Col. 7, lines 58-61; Col. 16, lines 4-12), there would have been no motivation to modify the intended functionality of Christensen to

filter coupons based on a user's location. The only motivation for such modification comes from Applicants own patent application, which is improper¹.

Further with respect to Claim 23 (and similarly for Claims 26 and 29), Applicants show that none of the cited references teach the claimed coupon database subscription methodology, where a merchant scans consumer profiles to decide which ones to subscribe to, and then electronic coupons are assigned to the consumer profiles to which the merchant has subscribed to. While Christensen may mention the ability for a retailer to access a database containing marketing information (Christensen Col. 21, lines 18-35), this database access is used to determine which products may be popular or may need further promotion (Col. 21, lines 18-20), or to determine product sales versus demographics (Col. 21, lines 20-23). This database is not used as a tool for a merchant to scan through consumer profiles *to determine which ones to subscribe to*, for subsequent assigning of coupons to such subscribed to profiles, as claimed. These claimed features advantageously allow a merchant to initially screen consumers, coupons are prepared for such screened consumers, and these coupons are then subsequently filtered based upon the consumer's location. None of the cited references teach this screening and filtering combination. Therefore, it is further shown that Claim 23 (and similarly for Claims 26 and 29) has been erroneously rejected as there are missing claimed elements not taught or suggested by the cited references.

Therefore, the rejection of Claims 23, 26 and 29 under 35 U.S.C. § 103 has been overcome.

III. Newly Added Claims

Applicants have added Claims 30-33 herewith. Specification support for Claims 30-32 is shown to be at least at Specification page 14, lines 16-27. Specification support for Claim 33 is shown to be at least at page 15, lines 29-32. Examination is respectfully requested.

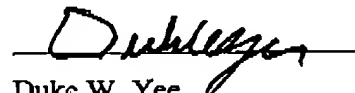
¹ The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 6/21/04

Respectfully submitted,



Duke W. Yee
Reg. No. 34,285

Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 367-2001
Attorneys for Applicants